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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,978

12/11/2006

James W. Halbrook

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1639

23628 7590 11/09/2009  
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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

11/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,978	<b>Applicant(s)</b> HALBROOK ET AL.	
	<b>Examiner</b> REBECCA L. ANDERSON	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,9,11,20,22-24,30,31,33,35,36,40 and 46-53 is/are pending in the application.
- 4a) Of the above claim(s) 11,20,30,31,33,35,36,40 and 46-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,23 and 24 is/are rejected.
- 7) ☒ Claim(s) 1,9 and 22-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

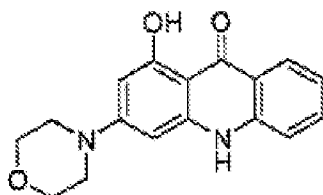
- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/6/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Claims 1, 9, 11, 20, 22-24, 30, 31, 33, 35, 36, 40 and 46-53 are currently pending in the instant application. Claims 11, 20, 30, 31, 33, 35, 36, 40 and 46-53 are withdrawn from consideration as being for non-elected subject matter. Claims 1, 23 and 24 are rejected. Claims 1, 9 and 22-24 are objected to as containing non-elected subject matter.

### *Election/Restrictions*

Applicant's election of Group I and the further election of the species:



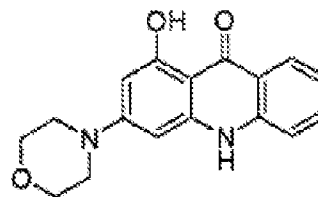
in the reply filed on 18 September 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

As per MPEP 803.02, the examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species appears allowable. Therefore, the search has been extended to the non-elected species of 7-(2-tetrahydrofuryl)-xanthone-2-carboxylic acid which is not allowable. As this non-elected species has been found

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not allowable, the Markush-type claims have been rejected and claims to the non-elected invention held withdrawn from further consideration.

Claims 1, 9 and 22-24 have been examined to the extent that they are readable



on the elected embodiment, the elected species of and the species 7-(2-tetrahydrofuryl)-xanthone-2-carboxylic acid. Since the non-elected species was found not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration.

It has been determined that the entire scope of claimed is not patentable.

### ***Claim Objections***

Claims 1, 9 and 22-24 are objected to as containing non-elected subject matter. Claims 1, 9 and 22-24 presented drawn solely to the elected embodiment would overcome this objection or an amendment to overcome the pending rejections in the instant application would overcome this objection as the search and examination of the claims according to MPEP 803.02 would continue.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 1 includes the phrase "a halide derivative thereof" in the definition of Rb. This phrase renders the claim indefinite as it is unclear what modifications are intended by the term "derivative". The term "derivative" is a compound, usually organic obtained from another compound by a simple chemical process or an organic compound containing a structural radical similar to that from which it is derived. Applicant has not provided what similar radicals are encompassed by the instant claims in regards to "a halide derivative thereof" which therefore renders the claims indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,835,158.

US Patent No. 3,835,158 discloses compounds of the formula (A) useful for the treatment of symptoms associated with allergic manifestations, such as asthmatic conditions (column 1, lines 5-20). Column 2, lines 40-50 disclose pharmaceutical compositions, including combinations with other compounds such as antibiotics. An example of a compound of the formula (A) is found in example 2 (3.), 7-(2-

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tetrahydrofuryl)-xanthone-2-carboxylic acid, column 13, which corresponds to applicants' claimed invention wherein A is a 5 membered aliphatic ring containing 1 heteroatom of oxygen; n is 0; each Z is CR<sub>b</sub> wherein R<sub>b</sub> is hydrogen; X is O; m is 1; and R<sub>1</sub> is carboxyl. The antibiotic of column 2 corresponds to the antineoplastic agent required in claim 24, see page 27 of the instant specification wherein antibiotics are listed in chemotherapeutic agents.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/  
Primary Examiner, AU 1626*

6 November 2009

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Rebecca Anderson  
Primary Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600